

## **REMARKS**

This paper is presented in response to the Office Action. By this paper, claim 7 is amended. Claims 1-3, 5-7, 10, 12-14 and 16-22 are pending.

Reconsideration of the application is respectfully requested in view of the aforementioned amendments and the following remarks. For the convenience and reference of the Examiner, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

### **I. General Considerations**

#### **A. Claim Amendments and/or Cancellations**

With particular reference to the claim amendments, Applicant notes that while claim 7 has been amended herein, such amendment has been made in the interest of expediting the allowance of this case. Notwithstanding, Applicant, may, on further consideration, determine that claims of broader scope than those now presented are supported. Accordingly, Applicant hereby reserves the right to file one or more continuing applications with claims broader in scope than the claims now presented.

Consistent with the points set forth above, Applicant submits that neither the claim amendments, claim cancellations nor statements advanced by the Applicant in this or any related case, constitute or should be construed as, an implicit or explicit surrender or disclaimer of claim scope with respect to the cited, or any other, references.

#### **B. Remarks**

Applicant respectfully notes that the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the patentable distinctions between any cited references and the invention, example embodiments of which are set forth in the claims of this application. Rather, and in consideration of the fact that various factors make it impractical to enumerate all the patentable distinctions between the invention and the cited art, as well as the fact that the Applicant has broad discretion in terms of the identification and consideration of the base(s) upon which the claims distinguish over the cited references, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration by the Applicant, in this case or any other, of: additional or alternative distinctions between the invention and the cited references; and/or, the merits of additional or alternative arguments.

Applicant notes as well that the remarks, or a lack of remarks, set forth herein are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited

references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teachings and purported prior art status of the cited references at any appropriate time.

## **II. Rejection of Claims 1-3, 5-7, 10, 12-14 and 16-22 under 35 U.S.C. § 112, first paragraph**

The Examiner has rejected claims 1-3, 5-7, 10, 12-14 and 16-22 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant respectfully disagrees with the contention of the Examiner and submits that for at least the reasons set forth below, the rejection of those claims should be withdrawn.

Applicant notes at the outset that it is well established that “A description as filed is presumed to be adequate, unless or until sufficient evidence of reasoning to the contrary has been presented by the examiner to rebut the presumption...The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of the evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” *MPEP § 2163.04 (emphasis added)*, see also *MPEP § 2163(II)(a)* (confirming that “There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed...””) (*emphasis added*).

In the present case, the rejection stated by the Examiner is based on nothing more than the vague and conclusory assertion that “...specification, as originally filed, does not describe these limitations in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Office Action at 2-3. As the foregoing makes clear, the Examiner has presented no evidence or analysis whatsoever in support of the rejection. Applicant respectfully submits that mere conclusory assertions are plainly inadequate to overcome the “strong presumption that an adequate written description of the claimed invention is present in the specification as filed.”

For at least the foregoing reasons, Applicant respectfully submits that the rejection of claims 1-3, 5-7, 10, 12-14 and 16-22 should be withdrawn.

## **III. Rejection of Claims 7, 10 and 12 under 35 U.S.C. § 112, second paragraph**

The Examiner has rejected claims 7, 10 and 12 under 35 U.S.C. § 112, second paragraph, as allegedly lacking definiteness. While Applicant disagrees with the Examiner, Applicant submits that in view of the amendment herein to claim 7, the rejection should be withdrawn.

**IV. Rejection of Claims 1-3, 5-7, 10, 12-14, 17-19 and 20-22 under 35 U.S.C. § 103**

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to clearly articulate the reason(s) why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. See *MPEP* § 2141.III. As stated by the U.S. Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_, 82 USPQ2d 1385 (2007), the analysis supporting a rejection made under 35 U.S.C. § 103 should be made explicit. Moreover, the Court also stated in *KSR* that "...[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* at 1396.

In the present case, the Examiner has rejected claims 1-3, 5-7, 10, 12, 17-19 and 21 under 35 U.S.C. § 103(a) over US 5,337,398 to Benzoni et al. ("*Benzoni*") in view of a non-patent reference ("*X2-MSA*"). Additionally, the Examiner has rejected claims 13-14 and 16 under 35 U.S.C. § 103(a) over *Benzoni* and the *X2-MSA* as applied to claims 1-3, 5-7, 10, 12, 17-19 and 21, and further in view of US 6,551,117 to Poplawski et al. ("*Poplawski*") and US 7,350,984 to Togami et al. ("*Togami*"). Finally, the Examiner has rejected claims 20 and 22 under 35 U.S.C. § 103(a) over *Benzoni* and the *X2-MSA* as applied to claims 1-3, 5-7, 10, 12, 17-19 and 21, and further in view of US 6,485,322 to Branch et al. ("*Branch*").

Applicant respectfully disagrees with the contention of the Examiner and submits that for at least the reasons set forth below, the claim rejections should be withdrawn.

**A. claims 1-3, 5-7, 10, 12, 17-19 and 21**

Applicant notes at the outset that the Examiner has again failed to specifically identify which portion(s) of *Benzoni* are believed by the Examiner to correspond to the claimed "transceiver housing" (claims 1, 7 and 13), "interior wall [of the transceiver housing]" (claim 7) and "bottom of the transceiver housing defining a pair of optical port slots..." (claims 1, 7 and 13), and has essentially repeated the rejection set forth in the Office Action mailed December 20, 2007. While this shortcoming in the rejection was clearly identified in Applicant's paper filed March 10, 2008, the Examiner has nonetheless failed to respond, in the Office Action mailed May 16, 2008, to the points advanced by the Applicant in that paper.

The failure of the Examiner to address Applicant's prior arguments is contrary to established examination guidelines. Particularly, Applicant notes that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, *take note of the applicant's argument and answer the substance of it.*" *M.P.E.P.* § 707.07(f). *Emphasis added.*

With regard to the continued failure of the Examiner to particularly identify what the Examiner believes to be the correspondence between *Benzoni* and the aforementioned elements of claims 1, 7 and

13, Applicant submits that if the origin of teachings and motivation set forth for the proposed combinations are believed by the Examiner to be present in the references, then the Applicant requests that this origin be set forth as suggested by MPEP 2144.08 III which states, “[w]here applicable, the finding should clearly articulate which portions of the reference support any rejection. Explicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. *Dillon*, 919 F.2d at 693, 16 USPQ2d at 1901; *In re Mills*, 916 F.2d 680, 683, 16 USPQ2d 1430, 1433 (Fed. Cir. 1990). Conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings.” *Emphasis added*.

With further reference to independent claim 7, Applicant has amended that claim, from which claims 10 and 12 depend, to recite in part “...a transceiver housing defining an interior within which the receive optical assembly and transmit optical assembly are at least partially disposed, the transceiver housing interior being partitioned into first and second optical ports by an interior wall of the transceiver housing such that a portion of the receive optical subassembly is positioned in the first optical port and a portion of the transmit optical subassembly is positioned in the second port, a bottom of the transceiver housing defining a pair of optical port slots such that each of the optical port slots opens into a corresponding optical port...” Support for this amendment can be found in various locations in the application, including at Figures 1a and 1c and the corresponding discussion. In contrast, the references, as presently understood, do not appear to teach or suggest these elements in combination with the other elements of claims 7, 10 and 12.

For at least the reasons set forth above, Applicant submits that the rejections of claims 1-3, 5-7, 10, 12-14, 16-19 and 21 are not well taken and should be withdrawn.

**B. claims 13-14 and 16**

Insofar as the rejection of claims 13-14 and 16 relies on the Examiner’s application of *Benzoni* to the rejection of claims 1-3, 5-7, 10, 12, 17-19 and 21, the rejection of claims 13-14 and 16 is defective for at least the reasons set forth in IV.A above.

Applicant notes that in connection with the rejection of claim 13, the Examiner has alleged that *Poplawski* “teach[es] a box-shaped housing with slots at the bottom” and that it would have been obvious to “combine the teaching of *Poplawski* et al. with the modified optical transceiver module of *Benzoni* et al. and X2-MSA because these slots are needed for accepting standard duplex connectors.” Office Action at 6-7. This rejection is problematic however.

For example, the Examiner has provided no evidence whatsoever in support of the assertion that the receptacles of the *Benzoni* device are “needed for accepting standard duplex connectors.” Inasmuch as

Figure 14 of *Benzoni* (relied upon by the Examiner) discloses receptacles that appear to be generally circular, however, it seems plain that the *Benzoni* receptacles are needed for something other than the rectangular connectors contemplated by *Poplawski* (see “receptacle openings 532 [534]” in Figure 14 of *Poplawski*).

In addition, it is clear that if the circular *Benzoni* receptacles are replaced with the rectangular receptacles of *Poplawski*, as the Examiner has alleged would be obvious to do, the *Benzoni* receptacles would no longer be suited for their intended purpose, namely, to be able to interface with the connectors contemplated by that reference. That is, the modification proposed by the Examiner would render the *Benzoni* device non-functional for its intended use. Accordingly, it is not clear that one of ordinary skill would have any reason to undertake the purportedly obvious modification advanced by the Examiner.

Finally, because the Examiner has failed to clearly identify which element(s) of *Benzoni* are believed by the Examiner to correspond to the claimed “housing,” the precise nature of the allegedly obvious combination of *Benzoni* and *Poplawski* is unclear. That is, the Examiner has not specified which element(s) of *Benzoni* would be obvious to replace with the “box-shaped housing” allegedly taught by *Poplawski*. In this regard, it was noted above that MPEP 2144.08 III states, “[w]here applicable, the finding should clearly articulate which portions of the reference support any rejection. Explicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. *Dillon*, 919 F.2d at 693, 16 USPQ2d at 1901; *In re Mills*, 916 F.2d 680, 683, 16 USPQ2d 1430, 1433 (Fed. Cir. 1990). Conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings.” *Emphasis added*.

### **C. claims 20 and 22**

By virtue of their dependence from claims 1 and 7, respectively, claims 20 and 22 require all the elements of those base claims. As noted above however, the Examiner has not shown that the references, when combined in the allegedly obvious fashion, teach or suggest all the elements of claims 1 and 7. Thus, the rejection of claims 20 and 22 is not well taken and should accordingly be withdrawn.

**CONCLUSION**

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-3, 5-7, 10, 12-14, and 16-22 is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 15th day of August 2008.

Respectfully submitted,

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